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WHITHAM CURTIS AND WHITHAM
RESTON INTERNATIONAL CENTER
SUITE 900
11800 SUNRISE VALLEY DRIVE
RESTON VA 20191

EXAMINER

NGUYEN, C

ART UNIT	PAPER NUMBER
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2764

DATE MAILED:

4
03/02/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/182,279

Applicant(s)

Coppersmith et al.

Examiner

Cuong H. Nguyen

Group Art Unit

2764



☒ Responsive to communication(s) filed on Oct 29, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-21 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-21 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

1. This Office Action is the answer to the communication received on 10/29/98 (the application papers).
2. Claims 1-21 are pending in this application.

Drawings

3. This application has been filed with 4 sheets of informal drawings, and they are not approved by the draftsman for minor errors indicated in the attachment.

Specification

4. The disclosure is objected to because of the following informalities: blanks on page 1 of the specification should be filled in.

Appropriate correction is required.

5. The following rejections are based on the examiner's broadest reasonable interpretation of the claims; *In re Pearson*, 181 USPQ 641 (CCPA 1974).

6. *Claim Rejections - 35 USC § 112*

Claim 1 recites a limitation "the authenticity" in claim's preamble. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

7. Claims 1, 5-6, 8-10, 15 are rejected under 35 U.S.C. § 103 as being unpatentable over Storch et al. (US Pat. 5,367,148), in view of Deo et al. (US Pat. 5,721,781), and further in view of Chew (US. Pat. 5,901,301).

A. Referring to claim 1: It is directed to a system for verifying an authenticity of a product (see '148, the summary of the invention), comprising:

- means for reading information from said tag (see '148 5:18-27; a well-known application for this means is a scanner at a check-out counter of a store).

Although the cited arts do not disclose a tag having a memory, but a similar teaching for this application was shown in the patent of Chew ('301 the abstract) (e.g. a tag having a memory (see Chew (US. Pat. 5,901,301) suggests a similar application with a microprocessor embedded in a smart card);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to implement the system as claimed with the suggestions of Chew's disclosure, and Deo et al. in Storch et al.'s invention for verifying the authenticity of a product, because these information are readily available at that time, and the verifying system would be very compact.

B. Referring to claims 5-6, 8-10, 15: The limitations of these claims recite the same (or less) claim's limitations as claim 1

above. The same analysis and reasoning set forth in the rejection of claim 1 are applied to these claims also because they are directed to a system that comprises similar means.

8. Claim 2 is directed to a system for verifying an authenticity of a product, wherein a tag is a smart card (see at least '303 the abstract; and the rationales for rejection for claim 1 are incorporated herein).

9. Claim 3 is directed to a system for verifying an authenticity of a product, wherein a tag is embedded into a product (see '148 Figs. 2-3, the rationales for rejection for claim 1 are incorporated herein).

10. Claim 4 is rejected under 35 U.S.C. § 103 as being unpatentable over Storch et al. (US Pat. 5,367,148), in view of Deo et al. (US Pat. 5,721,781), and further in view of Mob (US Pat. 5,740,250).

It is directed to a system for verifying an authenticity of a product, wherein information is encrypted using a private key, and is decrypted using a public key (see '250 claims 21, and 26, the rationales for rejection for claim 1 are incorporated herein).

It would have been obvious to one of ordinary skill in the art at the time of invention to implement the system as claimed

with the suggestions of Mob's disclosure, (and Deo et al.) in Storch et al.'s invention for verifying the authenticity of a product, because these information are readily available at that time, and the verifying system would be done in a conventional way.

11. Claim 7 is directed to a system for verifying an authenticity of a product, wherein a zero-knowledge protocol is used (see at least '634 the abstract, the rationales for rejection for claim 1 are incorporated herein).

It would have been obvious to one of ordinary skill in the art at the time of invention to implement the system as claimed with the suggestions of Guillou et al.'s disclosure, (and Deo et al.) in Storch et al.'s invention for verifying the authenticity of a product, because these information are readily available at that time, and the verifying system would be done in a conventional way.

12. Claim 11 is interpreted as: A system for verifying the authenticity comprises a product serial number (see at least '148 Fig. 3, the rationales for rejection for claim 1 are incorporated herein).

13. Claim 12 is interpreted as: A system for verifying the authenticity comprises a graphical image/indicia (of the product) (this limitation is very well-known on the market, e.g. an apple

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for "apple computer" .etc., the rationales for rejection for claim 1 are incorporated herein).

14. Claim 13 is rejected under 35 U.S.C. § 103 as being unpatentable over Storch et al. (US Pat. 5,367,148), in view of Deo et al. (US Pat. 5,721,781), and further in view of DiCesare et al. (US Pat. 5,971,435).

It is interpreted as a system for verifying the authenticity comprises an ownership history (of the product) (see '435 4:40-56, and claim 13; the rationales for rejection for claim 1 are incorporated herein).

It would have been obvious to one of ordinary skill in the art at the time of invention to implement the system as claimed with the suggestions of DiCesare et al. 's disclosure, (and Deo et al.) in Storch et al.'s invention for verifying the authenticity of a product, because these information are readily available at that time, and the verifying system would be sufficient with a product's past history.

15. Claim 14 is rejected under 35 U.S.C. § 103 as being unpatentable over Storch et al. (US Pat. 5,367,148), in view of Deo et al. (US Pat. 5,721,781), and further in view of Matyas et al. (US Pat. 5,164,988).

It is interpreted as a system for verifying the authenticity, wherein (authentication) information is erased

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after being read (e.g. see '988 19:25-26, and 20:2-4; the rationales for rejection for claim 1 are incorporated herein).

It would have been obvious to one of ordinary skill in the art at the time of invention to implement the system as claimed with the suggestions of Matyas et al. 's disclosure, (and Deo et al.) in Storch et al.'s invention for verifying the authenticity of a product, because these information are readily available at that time, and the verifying task would be known as "done" with that product.

16. Referring to claims 16-21: The limitations of these claims recite the same (or less) claim's limitations as claims 1-15 above. The same analysis and reasoning set forth in the rejection of claims 1-15 are applied to these claims also because they are directed to a method that using similar means (as the above system) to perform same steps.

Conclusion

17. Claims 1-21 are rejected.

18. Remarks:

A. About carrying forward another's Invention -- Design Choice to make integral. (In claim 1: a memory is embedded in a tag/label; and in claim 15: authentication information comprises authentication information (for a tag/label)).

In re Larson, 144 USPQ 347 (CCPA 1965) the court said:

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"While the brake disc and clamp of Tuttle et al. comprise several parts, they are rigidly secured together as a single unit. The constituent parts are so combined as to constitute a unitary whole. Webster's New International Dictionary (2nd edition) defines "integral" as "(2) composed of constituent parts making a whole; composite; integrated." We are inclined to agree with the board's construction of the term "integral" as used in claim 12. Then, too, we are inclined to agree with the position of the solicitor that the use of a one piece construction instead of the structure disclosed in Tuttle et al. would be merely a matter of obvious engineering choice. In re Fridolph, 50 CCPA 745, 89 F.2d 509, 135 USPQ 319.

And In re Lockhart, 90 USPQ 214 (CCPA 1951) the court said: After a careful examination of the record, we do not find ourselves in agreement with appellant's argument. Although it is true that invention may be present under some circumstances in making integral that which was separate before, we do not feel that such is the case here. Improved results only will not take the case out of the general rule. There is also a **requirement that the unification or integration involve more than mere mechanical skill.** In re Murray, 19 CCPA 739, 53 F.2d 541, 11 USPQ 155; in re Zabel et al., 38 CCPA 832, 186 F.2d 735, 88 USPQ 367. In this case, all of the essential elements of the appealed claims except

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integration of parts, are found in the references. It appears to us that the unity of parts would depend more upon the choice of the manufacturer, and the convenience and availability of the machines and tools necessary to construct the syringe, than on any inventive concept.

and Howard v. Detroit Stove Works, 150 US 164 (CCPA 1893) the court said: "As to the 3rd patent, it is void because the claims in it were clearly anticipated, and because it involves no invention to cast in one piece an article which has formerly been cast in two pieces and put together, nor to make the shape of the grate correspond with that of the firepot".

B. About elimination of a function in the claim (applying in claim 7 for "to make said authentication information resistant to duplication"):

In re Karlson, 136 USPQ 184 (CCPA 1963) the court said: " It is, of course, apparent that the elimination of the Shuldener screen and filler tube eliminates the functions of those elements. It is well-settled, however, that omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before In re Nelson, 40 CCPA 708, 198 F.2d 837, 95 USPQ 82; In re Eliot, 22 CCPA 1088, 76 F. 2d 309, 25 USPQ 111.

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In re Wilson, 153 USPQ 740 (CCPA 1967) the court said: "Claims are rejected since it was obvious to one of ordinary skill in the art to omit water from reference reaction when its function was not desired; subject matter is not patent able in absence of showing of unexpected result flowing from such omission.

Ex parte Rainut, 168 USPQ 375, 313 (PTO Bd. Of App. 1969) the court said "Omission of an element and its function where not needed is obvious" (applying to claims, 7, 17, and 15).

C. A. About Method-of-Use claims (for claims 16-21): When considering a method-of-use claim(steps for operating a specific structural assembly), patentable weight is given to the structure on which the claimed process is carried out in determining the obviousness of that process; *In re Kuehl*, 177 USPQ 250 (CCPA 1973); and

D. About structural limitations in method claims (applying to claims 16-21), the court said:

To be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure, *ex parte Pfeiffer*, 1962 C.D. 408 (1961).

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner

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Cuong H. Nguyen, whose telephone number is (703)305-4553. The examiner can normally be reached on Monday-Friday from 7:00 AM-4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached on (703)305-9768.

Any response to this action should be mailed to:

Box Issue Fee
Amendments
Commissioner of Patents and Trademarks
c/o Technology Center 2700
Washington, D.C. 20231

or faxed to: (703) 308-9051, (for formal communications intended for entry)

Or: (703) 305-0040 (for informal or draft communications,
please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-3900.

Cuong H. Nguyen
Feb. 25, 2000

~~James D. Tennant~~
~~Supervisory Motor Engineer~~
~~Technology Center 2700~~